

in combination for particular uses. As such, the level of unpredictability is not nearly so high as the rejection implies. The compounds recited for use in the presently claimed invention are known *per se* for other uses – what applicants discovered here is that these compounds (though known to be useful for disparate uses in the prior art) could be harnessed together for the treatment of angiotensin II-mediated diseases.

The present specification explains that representative combinations featuring particular species of the particular compound categories recited in the claims are useful for treating angiotensin II-mediated diseases. Because the other members of such classes are known *per se* for other therapeutic uses (see page 24, line 26 to page 27, line 20 of the present specification, which describe these compound categories), the examples provided in the present specification coupled with the general descriptions would enable one of ordinary skill in the art to utilize other members of those classes with no undue experimentation. The general description of how to make and use the combinations of the presently claimed invention is found on page 27, line 21 to page 38, line 4 of the present specification.

In the absence of any specific evidence that would suggest unpredictability for the recited method, the present specification should be accepted as enabling. No particular reasons are set forth in the rejection (other than the general recitation of the *Forman* factors themselves) that would suggest to a person of ordinary skill that the *Forman* factors, *in this case*, weigh against a finding of enablement. Thus, the presumption of enablement to which every specification is entitled has not been rebutted in the instant rejection.

Accordingly, withdrawal of the objection and rejection under the first paragraph of 35 U.S.C. 112 is requested.

Claims 20, 22-31, and 33 have been rejected under the second paragraph of 35 U.S.C. 112 for alleged indefiniteness. Reconsideration of the rejection is respectfully requested.

At the outset, applicants note that, in the parent application (Ser. No. 08/836,784), similar categories of compounds described by functional limitations were accepted. As

noted above, the therapeutic categories of compounds in the present claims are known *per se*. If there was any doubt as to the metes and bounds of these compound categories, one would need look no further than the present specification, which provides a description of the categories on page 24, line 26 to page 27, line 20.

Accordingly, withdrawal of the rejection under the second paragraph of 35 U.S.C. 112 is requested.

Claims 20 and 22-36 have been rejected over Inada in view of "Applicants admission" under 35 U.S.C. 103. Reconsideration of the rejection is respectfully requested.

First, applicants wish to emphasize the separate patentability of claims 32-36. These claims recite particular compounds or particular combinations of compound categories that are not suggested by the prior art. The rejection nowhere identifies any statement in either Inada or an "admission" that would motivate one of ordinary skill to combine the particular compounds or particular category of compounds recited in claims 32-36. Accordingly, the rejection should be carefully reconsidered as to each of claims 32-36.

As to the other claims, the rejection suggested that it is obvious to combine compounds which are known to be useful for treating the same disease. However, Inada merely discloses that compounds having AII antagonistic activity can be combined with a compound having diuretic activity or a compound having calcium antagonistic activity. There is no suggestion in Inada to further combine other compounds, such as members of the categories recited in instant claim 20. In fact, Inada teaches away from the combinations of the presently claimed invention insofar as Inada would have focused the attention of one ordinary skill on combining Ca antagonists or anti-diuretics with AII antagonists rather than ACE inhibitors or other categories recited in instant claim 20.